

REMARKS

Claims 1-8 are pending after entry of this paper. Claims 1-8 have been rejected.

Claims 1, 2, 5, 7 and 8 have been amended and claim 4 has been cancelled.

Claim 1 has been amended to recite that the device comprises a) a downwardly narrowing chamber; b) elements for feeding the slurry sample into the downwardly narrowing chamber; c) elements for feeding diluting liquid into the downwardly narrowing chamber; d) elements for removing solids contained in the slurry; e) elements for discharging both the liquid contained in the slurry and the liquid used for dilution; and f) an analyzer cell; wherein the downwardly narrowing chamber is connected to the analyzer measurement cell, and wherein the downwardly narrowing chamber comprises two opposite walls that are essentially parallel both with respect to each other and with respect to the corresponding walls of the analyzer measurement cell.” Support for this amendment may be found throughout the instant specification and the claims as originally filed.

Claim 2 has been amended to recite “The device according to claim 1, wherein the device further comprises at least one liquid conduit provided with a nozzle element to feed diluting liquid into the chamber and to agitate the liquid contained in the chamber.” Support for this amendment may be found throughout the instant specification and the claims as originally filed.

Claim 4 has been cancelled.

Claim 5 has been amended to recite “The device according to claim 2, further comprising a second downwardly narrowing chamber, wherein the downwardly narrowing chambers are in liquid connection with each other and are at least partly filled with liquid.”

Support for this amendment may be found throughout the instant specification and the claims as originally filed.

Claim 7 has been amended to recite “The device according to claim 5, wherein the cross-sectional area of the top part of the second chamber is larger than the cross-sectional area of the bottom part of the first chamber.” Support for this amendment may be found throughout the instant specification and the claims as originally filed.

Claim 8 has been amended to recite “The device according to claim 5, wherein the liquid conduit includes nozzle elements comprising at least one nozzle for feeding diluting liquid into both chambers to advantageously agitate the liquid contained in the chambers.” Support for this amendment may be found throughout the instant specification and the claims as originally filed.

No new matter has been introduced by these amendments. Reconsideration and withdrawal of the pending rejections in view of the above claim amendments and below remarks are respectfully requested.

Response to Rejections under 35 U.S.C. §112, second paragraph

Claims 1-8 have been rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite. Specifically, the Examiner contends that the terms “the analyzer measurement cell” and “the respective walls of the measurement cell” in claim 1 and “the flow aperture of the top part of the second chamber” of claim 7 lack antecedent bases.

Without admitting the verity of the Examiner’s contention, and solely for the purpose of furthering prosecution without prejudice towards or waiver of any subject matter, applicants have amended claims 1 and 7. The term “the analyzer measurement cell” has been replaced with “an analyzer measurement cell” in line 10 of claim 1. Further, the term “the respective walls of the measurement cell” in claim 1 has been replaced with “the corresponding walls of an analyzer measurement cell”. Support for these amendments can be found throughout the specification, for example at page 2, lines 20-21 and 27-29. Applicants have also amended claim 7 to delete the terms “the flow aperture of the top part of the second chamber” and “the flow aperture of the bottom part of the first chamber”.

Applicants believe the claims as amended to be in full compliance with the requirements of 35 U.S.C. §112, and respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112.

Response to Rejections under 35 U.S.C. §102

Claims 1-4 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent No. 4,021,021 to Hall et al. (“Hall”). Applicants respectfully disagree for the reasons set forth below.

In the first instance, Hall fails to disclose an analyzer measurement cell. Claim 1 requires an analyzer measurement cell. Accordingly, Hall does not disclose each and every element of claim 1, and therefore does not anticipate claim 1.

The Examiner contends that Hall discloses a device comprising elements for feeding (items **4**, **15**, and **8**) as recited in claim 1 (Office Action, page 2). Items **4**, **15**, and **8** of Hall, however, do not meet the claim element of “elements for feeding the slurry sample into at least one downwardly narrowing chamber” as recited in claim 1. Item **4** of Hall is a “flexible feeder unit” for feeding “a fine stream of clay powder” (column 2, lines 16-19). Item **15** of Hall is an “inlet” for feeding “[m]akeup water or other liquid”, not a slurry sample (column 2, lines 50-53). Thus, neither item **4** nor **15** are “elements for feeding a slurry sample”, as recited in claim 1. Item **8** is a “flow control cylinder” that allows the wetted clay powder to flow *within* the wetting tank **3** (column 2, lines 38-44) (emphasis added). Since the wetted clay powder in Hall is created *within* the tank, item **8** also fails to meet the claim element of “feeding the slurry sample *into* at least one downwardly narrowing chamber.” Accordingly, Hall fails to disclose “elements for feeding the slurry sample into at least one downwardly narrowing chamber” as recited in claim 1.

The Examiner also contends that Hall discloses “a narrowing chamber **3** including essentially parallel walls (see Fig. 1)” as recited in claim 1 (Office Action, page 2). Applicants assert that Hall fails to disclose a “downwardly narrowing chamber [with] opposite walls that are essentially parallel both with respect to each other and with *respect to the corresponding walls of an analyzer measurement cell*” as recited in amended claim 1 because Hall fails to disclose an analyzer measurement cell. Thus, the walls of Hall cannot be “essentially parallel ... with

respect to the corresponding walls of an analyzer measurement cell.” Accordingly, Hall fails to disclose each and every element of claim 1.

Regarding claims 2 and 4, the Examiner contends that Hall discloses a nozzle element at “the end of **15**” (Office Action, page 2). Applicants have cancelled claim 4. Applicants respectfully disagree that item **15** of Hall contains a nozzle element as recited in claim 2. Claim 2 specifically recites that the device has “at least one liquid conduit provide with a nozzle element ...” The specification illustrates that the nozzle elements identified on Figure 2 as items **14**, **15**, and **16** are attached to liquid conduit **13** (Specification page 8, lines 4-12). The nozzles are installed for “efficient agitation” of the fluid within the chamber(s) of the claimed device (claim 2; Specification page 10, lines 7-8). Hall fails to disclose a nozzle element at the end of item **15** (Figure 1). Indeed, since Hall discloses an independent means for agitation, namely a motorized mixer comprising items **11-14** of Figure 1, the nozzle as recited in claim 2 is not necessary at the end of item **15**. Accordingly, Hall does not disclose each and every element of claim 2.

Regarding claim 3, the Examiner contends that conduit **8** of Hall is symmetrically installed (Office Action, page 2). Claim 3 is dependent on and therefore includes all the elements of claim 2. Thus, since the flow control cylinder **8** of Hall clearly does not include the nozzle element(s) recited in claim 2 as discussed *supra*, claim 3 is also distinguishable over Hall.

In summary, Hall does not teach each and every element of claims 1-3. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3 under 35 U.S.C. §102 over Hall.

Response to Rejections under 35 U.S.C. §103

Dependent claims 5-8 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious over Hall alone. The Examiner admits that Hall fails to disclose the second chamber of dependent claims 5-8 and identifies two cases, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7th Cir. 1977) in support of the rejection. Applicants submit that dependent claims 5-8 include all elements of claims 1 and 2. Therefore, for at least similar reasons as to why claims 1 and 2 are believed allowable as discussed *supra*, the dependent claims are also allowable. Further, applicants disagree with the 35 U.S.C. §103(a) rejection for the additional reasons set forth below.

As an initial matter, applicants respectfully submit that the Examiner has not clearly articulated the reasons why the claims 5-8 are obvious. MPEP §2142 notes that an Examiner has the initial burden in establishing a *prima facie* case of obviousness by providing “clear articulation of the reason(s) why the claimed invention would have been obvious”. The Examiner admits that the second chamber of claims 5-8 is not disclosed in Hall, but supports the obviousness rejection with two cases (Office Action, page 3). The procedure for use of legal precedent in support of an obviousness rejection is stated in MPEP §2144.04 as follows:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

Applicants respectfully submit that the Examiner’s citation to court decisions without specifically explaining how the facts of the cases and the present invention are similar is

insufficient to establish a *prima facie* case of obviousness. Applicants, however, will attempt to respond to the 35 U.S.C. §103 rejection for the purpose of furthering prosecution.

The initial case cited by the Examiner, *In re Harza*, 274 F.2d 669, is identified in the MPEP §2144.03 (VI)(B) entitled “Legal Precedent as Source of Supporting Rationale – Duplication of Parts” which states:

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies in the joint, and a plurality of "ribs" projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.)

The other case cited by the Examiner, *St. Regis Co. v. Bemis Co.*, 193 USPQ 8 (7th Cir. 1997), is not identified in the MPEP. In *St. Regis*, the Court of Appeals for the Seventh Circuit (“Seventh Circuit”) found claims directed to specialized bags invalid as obvious under 35 U.S.C. §103. Specifically, the Seventh Circuit found that the combination of elements in the bags was not “synergistic... resulting in an effect greater than the sum of the several effects taken separately”, and the claims directed to the bags were therefore invalid as obvious under 35 U.S.C. §103. *St. Regis*, 193 USPQ at 11. For the purposes of this response, applicants assume that the Examiner cited the two cases for the proposition that the second chamber of claims 5-8 was a “mere duplication” of the first chamber, and the two-chamber device does not produce a “new and unexpected result” compared to a single chamber device. MPEP §2144.03(VI)(B). Applicants respectfully disagree.

The second chamber of claims 5-8 is not necessarily a “mere duplication” of the first chamber. For example, the second chamber is shaped differently than the first chamber in

the embodiments illustrated in Figures 1-4. The first chamber **1** is a truncated pyramid or cone with four downward sloping walls (Specification page 3, lines 24-27; Figures 1-4). The second chamber **2** has two opposite parallel walls and two opposite downward sloping walls (Specification page 4, lines 19-23; Figures 1-4). Furthermore, the first chamber has a different purpose than the second chamber. Specifically, the first chamber is a “supply chamber” for receipt of “the solids-containing slurry sample”, and the second chamber is a “discharge chamber” for discharge of solids from the slurry sample into the analyzer measurement cell (Specification page 2, lines 5-9). Hence, the second chamber is not a “mere duplication” of the first chamber.

Furthermore, the two-chamber device of claims 5-8 can provide new and useful results over a single chamber device. For example, the two-chamber device can be used “where a remarkable degree of diluting is required” because “the larger volume of the two chambers [facilitates] the diluting...” (Specification page 3, lines 19-23). Moreover, the second chamber “is designed so that the heavy particles” in the slurry sample that may have failed to mix properly in the first chamber “drop into the second chamber and are remixed in the slurry” prior to entering the analyzer measurement cell (Specification page 7, lines 8-10). Claims 5-8 are therefore not obvious under 35 U.S.C. §103 over Hall and in view of the two cases cited by the Examiner because the second chamber is not a mere duplication of the first chamber, and the two-chamber device provides new and useful results over a single chamber device.

Thus, applicants respectfully request reconsideration and withdrawal of the rejection of dependent claims 5-8 under 35 U.S.C. §103 over Hall alone.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3 and 5-8 and allowance of this application. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 4819-4747.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 4819-4747.

Respectfully submitted,
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